



DISPUTE RESOLUTION SERVICE

D00022283

Decision of Independent Expert

Facebook, Inc.

and

Praeya Sahota

1. The Parties:

Complainant: Facebook, Inc.
1601 Willow Road
Menlo Park
California
94025
United States

Respondent: Praeya Sahota
Flat 22 exmoor house
Belvedere
DA17 6FB
United Kingdom

2. The Domain Name:

facebookshop.co.uk (the "Domain Name")

3. Procedural History:

The complaint was received by Nominet on 28 January 2020. On 30 January 2020 the complaint was validated and notification of it sent to the parties. On 18 February 2020 a response reminder was sent. The Respondent failed to respond. Mediation being neither possible nor permissible in the circumstances under paragraph 10.1 of the Nominet UK Dispute Resolution

Service Policy (the "Policy"), Nominet so informed the Complainant on 21 February 2020. On 4 March 2020, the Complainant paid Nominet the appropriate fee and elected that a full decision of an Expert be provided in accordance with paragraph 12.2 of the Policy.

On 5 March 2020 Nominet invited David Kreider to provide a decision in this case. I have confirmed to Nominet that I am independent of each of the parties and that to the best of my knowledge and belief there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.

4. Factual Background

The Complainant, Facebook, Inc., describes itself as the world's leading provider of online social networking services. Founded in 2004, Facebook allows Internet users to stay connected with friends and family, and to share information, mainly via its website available at www.facebook.com.

The Complainant has made the following submissions of fact which I accept, having regard to the Complainant's evidence in support and taking into account that the Respondent has not challenged these submissions or adduced any evidence to the contrary:

- 1) With more than 2.32 billion monthly active users on average worldwide, the Complainant's FACEBOOK trade mark is one of the most famous and well-recognised online trade marks in the world.
- 2) 1.74 billion users access Facebook on smartphones and other mobile devices. In 2019, the Complainant's mobile "app" ranked as the most frequently downloaded application in the world.
- 3) The Complainant's main website www.facebook.com is currently ranked as the 5th most visited website in the world and 9th in the United Kingdom (where the Respondent is based).
- 4) The term FACEBOOK is overwhelmingly and probably exclusively associated with the Complainant. All search results on the first four pages obtained by typing the term FACEBOOK in Google search engine available at www.google.com and www.google.co.uk refer to the Complainant.

Given that the Complainant's social networking business is conducted exclusively online, the Complainant maintains numerous domain names, each

with its FACEBOOK trade mark occupying the second or third level domains, which are at the heart of its business – providing access for millions of users around the world to avail themselves of the Complainant’s online social networking services.

The Complainant is also the owner of a number of registered trade marks including:

- 5) European Union Trade Mark Number 009151192 for FACEBOOK registered on 17 December 2010;
- 6) United Kingdom Trade Mark Number UK00003329154 for FACEBOOK registered on 26 October 2018;
- 7) International Registration Number 1075094 for the  logo, registered on 16 July 2010, designating Albania, Australia, Bahrain, Bosnia and Herzegovina, China, Croatia, Egypt, France, Georgia, Ghana, Iceland, Japan, Kenya, Montenegro, Morocco, North Macedonia, Norway, the Republic of Korea, the Russian Federation, Serbia, Singapore, Sudan, Switzerland, Turkey, Ukraine and Viet Nam; and
- 8) United States Trade Mark Number 3041791 for FACEBOOK registered on 10 January 2006 (first use in commerce in 2004) (class 38).

The Domain Name <facebookshop.co.uk> was registered on 21 October 2014. It resolves to the registrar’s web site. On 24 July 2019, the Complainant’s representatives, Hogan Lovells, wrote to the Respondent seeking the transfer of the Domain Name to the Complainant. No response was received to this letter or to a chaser letter sent to the Respondent on 11 November 2019.

5. Parties’ Contentions

The Complaint

The Complainant’s Rights

The Complainant asserts that it has Rights, within the meaning of paragraph 1 of the Policy, in respect of the FACEBOOK trade mark by virtue of its registration in various jurisdictions around the world and use of the mark in commerce since 2004.

The Complainant submits that the Domain Name is identical or similar to the FACEBOOK trade mark in which it has Rights, in that the Domain Name incorporates the Complainant’s FACEBOOK trade mark in its entirety, with the mere addition of the generic term "shop", which does not materially affect the

impression given by the Domain Name in relation to the Complainant's trade mark. The Complainant observes that the country code domain extension ".co.uk" is a functional requirement of registration that is immaterial for purposes of the present inquiry under the Policy.

Abusive Registration

The Complainant submits that the Domain Name was registered and is being used in a manner which has taken unfair advantage of and has been unfairly detrimental to the Complainant's Rights, pursuant to paragraph 1 of the DRS Policy. The Complainant notes in its complaint, however, that the Policy requires only that a complainant prove either that a disputed domain name (1) was registered, or (2) is being used in bad faith. That is, the test is disjunctive and proof of only one element of the test is sufficient to show abusive registration under the Policy.

The Complainant avers that its FACEBOOK trade mark is inherently distinctive and well-known throughout the world in connection with a social network, has been continuously and extensively used since its launch in 2004, and rapidly acquired considerable goodwill and renown worldwide. Moreover, the Complainant has not authorised, licensed or otherwise allowed the Respondent to use its FACEBOOK trade mark in a domain name or otherwise. Indeed, the Respondent is not connected to the Complainant in any manner.

Against this background, the Complainant submits: "[I]t would be inconceivable for the Respondent to argue that she did not have knowledge of the Complainant's FACEBOOK trade mark at the time of registration of the Domain Name in 2014. See, *Facebook, Inc. v. Steven Cameron*, DRS 16992 (thefacebook.co.uk).

The Complainant explains that it had sent to the Respondent a cease and desist letter asserting its rights in the FACEBOOK trade mark and requesting transfer of the Domain Name. The Respondent did not reply to the letters or come forward with any explanation for having selected the Domain Name.

The Complainant submits that the Respondent registered the Domain Name with prior knowledge of the Complainant's Rights and that Nominet Experts under the DRS Policy have generally held that such prior knowledge strongly suggests a finding of Abusive Registration. See *Verbatim Limited v. Michael Toth*, DRS 04331 <verbatim.co.uk>.

The Complainant concludes: "it appears that the Domain Name has been passively held by the Respondent since its creation. Given the nature of the Domain Name, which reproduces the Complainant's well-known trade mark in its entirety with the mere addition of the word 'shop', the Complainant submits that such passive holding indicates that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is

registered to, operated or authorised by, or otherwise connected with the Complainant in accordance with paragraph 5.1.2 of the DRS Policy. *See also, Enterprise Holdings, Inc. and Leszek Tomczakowski Ltd, DRS 17902.*

Finally, the Complainant notes there are no circumstances to suggest that the Respondent's registration is not an Abusive Registration, as set out under paragraph 8 of the DRS Policy. The Respondent cannot claim that she is commonly known by a name or legitimately connected with its FACEBOOK mark, which is identical or similar to the Domain Name, given the notoriety surrounding the Complainant's FACEBOOK trade mark and its exclusive association with the Complainant.

The Response

The Respondent made no response.

The Reply

There being no Response, there was no scope for a Reply.

6. Discussions and Findings

As no Response was filed in these proceedings, the Complainant could have sought a summary decision. However, the Complainant seeks and has paid for a full decision, as it is entitled to do (paragraph 12.1 of the Policy).

To succeed under the Policy, the Complainant must prove first, that it has Rights in respect of a name or mark that is identical or similar to the Domain Name (paragraph 2.1.1 of the Policy) and second, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2.1.2 of the Policy). The Complainant must prove to the Expert that both elements are present on the balance of probabilities (paragraph 2.2 of the Policy), and this is so even if a Response has not been filed. The Expert may nonetheless draw appropriate inferences from the fact that the Respondent has failed to file a Response (paragraph 24.8 of the Policy).

Complainant's Rights

Paragraph 1 of the DRS Policy defines rights to mean rights enforceable by the Complainant, whether under English law or otherwise, which may include rights in descriptive terms which have acquired a secondary meaning.

The Complainant asserts rights in the FACEBOOK trade mark by virtue of its registration in various jurisdictions around the world and longstanding use of the mark in commerce.

The Expert is satisfied that the trade mark FACEBOOK is identical or similar to the Domain Name (ignoring, as the Expert is required to do, the first and

second level suffixes of the Domain Name). The addition of the generic word “shop” to “facebook” in the Domain Name does not distinguish the Domain Name from FACEBOOK. *Facebook, Inc. v. Steven Cameron*, DRS 16992 (thefacebook.co.uk). A number of Experts have reached the same conclusion on similar facts. See for example the Appeal decision in DRS 00248 (Seiko-shop.co.uk).

Abusive Registration

Paragraph 1 of the Policy defines abusive registration as a Domain Name which either (i) was registered or otherwise acquired, in a manner, which at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant’s rights; OR (ii) is being or has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s rights.

A non-exhaustive list of factors which may be evidence that the Domain Name is an abusive registration is set out in paragraph 5.1 of the Policy. A non-exhaustive list of countervailing factors is set out in paragraph 8.1 of the Policy.

In the Expert’s view, in the particular circumstances of this case, a detailed analysis of those provisions of the Policy is unnecessary.

On the evidence before the Expert, the trade mark FACEBOOK is exclusively referable to the Complainant. It is a distinctive name and a very famous name. It is inconceivable that the Respondent can have registered that name without having the Complainant firmly in mind.

The Expert agrees with the Complainant that there is no obvious reason why the Respondent might be said to have been justified in registering the Domain Name and the Respondent has elected not to come forward with any explanation for her registration of the Domain Name.

As the Expert observed in *Chivas Brothers Limited and David William Plenderleith*, DRS 0292, where a Respondent registers a Domain Name:

- 1) which is identical to a name in respect of which the Complainant has rights; and
- 2) where that name is exclusively referable to the Complainant; and
- 3) where there is no obvious justification for the Respondent having adopted that name for the Domain Name; and
- 4) where the Respondent has come forward with no explanation for having selected the Domain Name,

it will ordinarily be reasonable for an expert to infer first that the Respondent registered the Domain Name for a purpose and secondly that that purpose was abusive. In this case the Expert draws those inferences.

Accordingly, the Panel finds on the balance of probabilities that the Respondent registered the Domain Name for one or more of the purposes contained in the non-exhaustive list set out in paragraph 3(a)(i) of the Policy or for some other abusive purpose.

7. Decision

I find that the Complainant has Rights in a name, which is identical to the Domain Name, and that the Complainant has shown that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

I, therefore, determine that the Domain Name, facebookshop.co.uk, should be transferred to the Complainant.

Signed



Dated 14 March 2020